

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number

Q94324

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on _____

Application Number
10/574,840

Filed
January 19, 2007

Confirmation Number: 5035
First Named Inventor
Hideki KITANO

Signature
Typed or
printed name

Art Unit
1722

Examiner
Anna L. Verderame

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

- ☒ The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

CORRESPONDENCE ADDRESS

Direct all correspondence to the address for SUGHRUE MION, PLLC filed under the Customer Number listed below:

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

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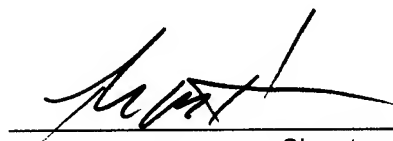
☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71.

☐ Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 64,676

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Thomas M. Hunter

Typed or printed name

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Telephone number

October 28, 2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q94324

Hideki KITANO, et al.

Appln. No.: 10/574,840

Group Art Unit: 1722

Confirmation No.: 5035

Examiner: Anna L. Verderame

Filed: January 19, 2007

For: PHOTO-CURABLE TRANSFER SHEET, PROCESS FOR THE PREPARATION OF
OPTICAL INFORMATION RECORDING MEDIUM USING THE SHEET, AND
OPTICAL INFORMATION RECORDING MEDIUM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the
Examiner's Final Office Action dated April 28, 2011, Applicant files this Pre-Appeal Brief
Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Appellants turn now to the rejections at issue:

Claims 1-10, 12 and 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable
over WO 03/032305 to Kitano et al.; Claim 11 stands rejected under 35 U.S.C. § 103(a) as being
unpatentable over Kitano in view of U.S. Patent No. 6,586,496 to Takamatsu et al.; and Claims
11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kitano in view of
U.S. Patent Application Publication No. 2003/0129385 to Hojo et al.

Appellants respectfully traverse the rejections for the reasons set forth at pages 2-5 of the
Response filed July 28, 2011, and for the following reasons.

The Examiner mischaracterized Appellants' arguments in her response set forth in the Advisory Action dated August 9, 2011.

In the Advisory Action dated August 9, 2011, the Examiner asserts that "Applicants argue that despite the fact that Kitano discloses, within the reference, the addition of the same tackifiers as Applicants, in amounts sufficient to improve the processing properties of the adhesive that one of ordinary skill in the art would have to engage in blind trial and error to arrive at Applicants' invention."

However, Appellants did not argue "that despite the fact that Kitano discloses, within the reference, the addition of the same tackifiers as Applicants, in amounts sufficient to improve the processing properties of the adhesive that one of ordinary skill in the art would have to engage in blind trial and error to arrive at Applicants' invention," as the Examiner asserts. Rather, Appellants argued that the present invention is directed to a specific tackifier, which yields inventive results. See, pages 2-5 of the Response filed July 28, 2011.

In this regard, Appellants argued in favor of patentability for the reason that it would not have been obvious to one skilled in the art to select the presently claimed tackifier from the laundry list of tackifiers and resins disclosed in Kitano. See, page 5 of the Response filed July 28, 2011.

More particularly, according to Kitano, the purpose of using the additives is for improving processing properties such as laminating properties, whereas the object of the present invention is to provide a transfer sheet that does not bleed the components of the transfer layer on its side and does not generate variation in the thickness of the transfer sheet (transfer layer).

Kitano is completely silent with respect to issues relating to bleeding of the components of the transfer layer on its side and variation of the thickness. Thus, it would have been difficult

for one skilled in the art to select the specific tackifier of the present invention from the numerous resins disclosed in Kitano. That is, one skilled in the art would need to undertake undue experimentation, i.e., blind trial and error. Moreover, it is not apparent whether the use of the Composition 5 containing no tackifier *per se* is appropriate or not, and whether the use of the additives *per se* is appropriate or not, because Kitano is completely silent with respect issues relating to bleeding of the components of the transfer layer on its side and variation of the thickness.

Furthermore, with regard to the processing properties as disclosed in Kitano, processing properties refer to properties present during the process for forming a sheet (e.g., laminating properties). In contrast, bleeding of the components of the transfer layer on its side and variations in thickness are in reference to storage stability.

For the foregoing reasons, it is respectfully submitted that the cited references fail to render obvious the present claims.

Accordingly, Appellants respectfully request the reconsideration and withdrawal of the foregoing rejection.

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Date: October 28, 2011

Respectfully submitted,



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